

## REMARKS

Claims 1 to 7, 10 and 16 are pending. A December 10, 2002 Final rejection in this case rejected all claims. On January 24, 2003, Applicant filed an AMENDMENT AFTER FINAL REJECTION UNDER 37 C.F.R. §1.116, on March 7, 2003, Applicant filed a Request for Continued Examination (RCE) in this case requesting consideration of the January 24 AMENDMENT. On March 19, 2003 Applicant filed an AMENDMENT PRIOR TO INITIAL EXAMINATION AFTER RCE with amended claims. (Copies of the AMENDMENT PRIOR TO INITIAL EXAMINATION AFTER RCE and Applicant's stamped filing receipt are attached hereto.) PAIR confirms the March 19 filing. On March 28, 2003, the PTO issued an Office Action, that considered Applicant's March 7, 2003 AMENDMENT AFTER FINAL REJECTION UNDER 37 C.F.R. §1.116 but not Applicant's March 19, 2003 AMENDMENT PRIOR TO INITIAL EXAMINATION AFTER RCE. Reconsideration of the March 28, 2003 Office Action is respectfully requested for the following reasons:

## I. STATUS OF THE CLAIMS

Claims 1 to 7, 10 and 16 are pending. The pending claims are those as amended by Applicant's March 19, 2003 AMENDMENT PRIOR TO INITIAL EXAMINATION AFTER RCE and as amended by this Amendment.

## II. OBJECTIONS TO THE CLAIMS

Claim 6 is amended by this Amendment to overcome the objection.

## III. 35 U.S.C. §112 OBJECTIONS AND REJECTIONS.

The withdrawal of the 35 U.S.C. §112, first paragraph rejection and 35 U.S.C. §112, second paragraph B, C, G, and J rejections is noted and appreciated.

## IV. 35 U.S.C. §112, SECOND PARAGRAPH REJECTIONS

This Amendment amends the claims to “plate” and claim 1 to a substrate comprising an array of cells to overcome A and D of the rejection. The March 19, 2003 AMENDMENT PRIOR TO INITIAL EXAMINATION AFTER RCE amendments should overcome B and C rejections.

## V. 35 U.S.C. §103(A) REJECTION

Claims 1-7, 10 and 16 were rejected under 35 U.S.C. 103(a) over Eigen et al , Bottenbruch et al and Bayer.

The Office Action states:

For claims 1, 10 and I 6, Eigen et al (see entire document) teaches a polycarbonate substrate with an array of reactions cells that contains a polycarbonate monofilm covering (i.e., each of the wells contains "two opposing walls", a concave bottom, and "comprises" a polycarbonate monofilm covering) (see Eigen et al, figures 1-5 and 10; see especially elements 2, 11 and 49; see also column 1 paragraphs 1-3).

Office Action page 8, last paragraph.

First, these references are not properly combinable without the “reason to combine” showing required by *In re Lee*, 277 F.3d 1338, \_\_\_\_\_, 61 USPQ 2d 1430, 1433-1434 (Fed. Cir. 2002). Additionally even if improperly combined, the references do not establish a prima facie case of obviousness. Claim 1 claims “two opposing walls comprising permeable polycarbonate film.” Eigen et al , Bottenbruch et al and Bayer do not teach or suggest “two opposing walls comprising permeable polycarbonate film” The references do not establish a prima facie case of obviousness and the rejection must be withdrawn. *In re Deuel*, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995).

The issue of “two opposing walls comprising permeable polycarbonate film” was raised at the March 12, 2003 interview. The notes of Applicant’s representative from that interview indicate that the issue had been addressed and resolved. Indeed, the issue of “two opposing walls comprising permeable polycarbonate film” was addressed by the February 3, 2002 Office Action allowance of claim 15 and Applicant’s subsequent

September 23, 2002 amendment incorporating the claim 15 limitation into claim 1 followed by the PTO's withdrawal of the February 3, 2002 Office Action art rejection.

The present Office Action fails to point out the locations of particular "relied upon" teachings in the references, except in some instances to state "see entire document." While addressing "two opposing walls," the Office Action states nothing about teachings of "two opposing walls comprising permeable polycarbonate film," (claim 1; FIG. 4 with accompanying specification description). If the PTO disagrees that the 35 U.S.C. 103(a) rejection over Eigen et al, Bottenbruch et al and Bayer should be withdrawn, the PTO is respectfully requested to withdraw the present Office Action, reissue another office action specifically identifying disclosure in Eigen et al, Bottenbruch et al and Bayer that purportedly teaches or suggests "two opposing walls comprising permeable polycarbonate film" and restart the period for response. *See In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) ("[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference....").

In view of the foregoing amendments and remarks, it is respectfully submitted that claims 1 to 7, 10 and 16 are allowable. Reconsideration and allowance are requested.

Should the Examiner believe that any further action is necessary in order to place this application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Philip D. Freedman  
Reg. No. 24,163  
Philip D. Freedman PC  
Customer Number 25101  
6000 Wescott Hills Way  
Alexandria, Virginia 22315-4747  
(703) 313-0171  
Fax: (703) 313-9322  
Email: tekesq@tekesq.com

Alexandria, Virginia

4/25, 2003